

# *What every product manager should know about Intellectual Property: Patents, Copyrights, Trademarks*

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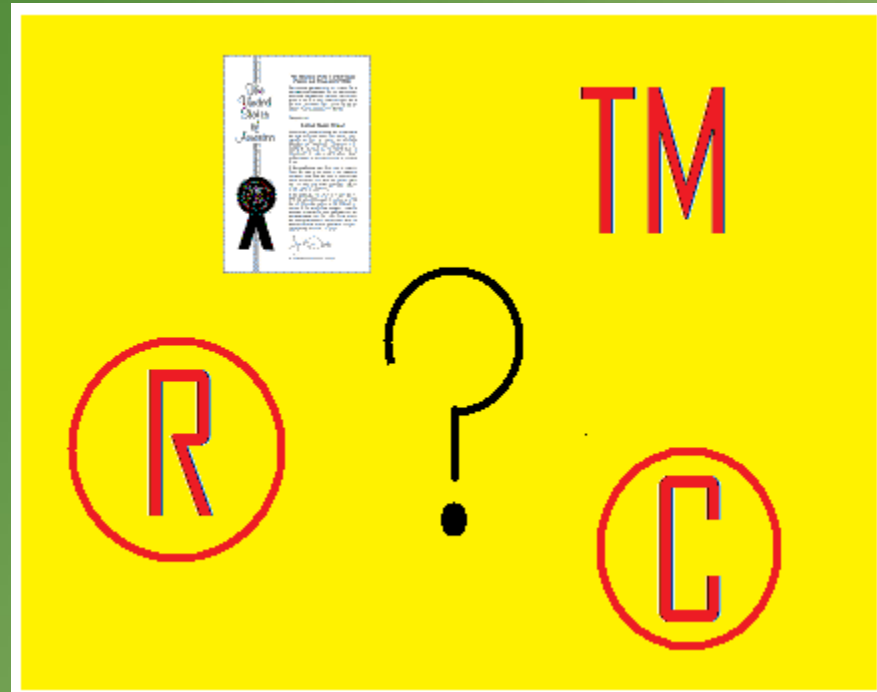
# Disclaimer

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- ❖ This presentation does not constitute legal advice and should not be relied upon as such
- ❖ This presentation does not commence an attorney-client relationship
- ❖ Any communication during this presentation is not privileged or confidential
- ❖ Some portions may be overly generalized for explanation
- ❖ To prevent injury, please hold on to your seats during the exciting parts of this presentation

# Is there any protectable intellectual property in a watch?

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# Protection of Design

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**Design Patent**

**D506936**

# Agenda

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- ❖ **Hickman Palermo Truong & Becker**
- ❖ **Trademarks**
- ❖ **Copyrights**
- ❖ **Patents**





**Hickman Palermo Truong & Becker LLP**  
INTELLECTUAL PROPERTY LAW



Focusing on patent procurement for computer,  
networking, software, and video technologies



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# Hickman Palermo Truong & Becker LLP

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## ❖ **Services**

- ❖ **Counseling in all areas of Intellectual Property**
- ❖ **Patent preparation and prosecution in the US and abroad**
- ❖ **Trademark search, clearance, and registration**
- ❖ **Copyright registration**



# Hickman Palermo Truong & Becker LLP

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## ❖ Services

- ❖ Software and technology licensing, development, and related agreements
- ❖ Patent and trademark risk evaluation, patent monitoring and pre-litigation claim evaluation, including guidance on responding to claims by patent trolls
- ❖ Anonymous patent acquisition and sale or licensing



# Varun A. Shah, Esq.

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## ❖ Education

- ❖ Computer Science, B.S., *Upper Division Honors*
- ❖ Law, Juris Doctorate (JD)

## ❖ Experience

- ❖ Intel – *Engineering*
- ❖ Motorola – *Patent Portfolio Management*
- ❖ Superior Court, Judge Michael D. Jones – *Law Clerk*
- ❖ Hayes Soloway – *Patent Prosecution*
- ❖ Osha Liang – *Patent Prosecution*
- ❖ Hickman Palermo Truong & Becker – *Patent Prosecution*

# Trademarks

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❖ Sign or Indicator used by individual, business, or other entity to identify products or services

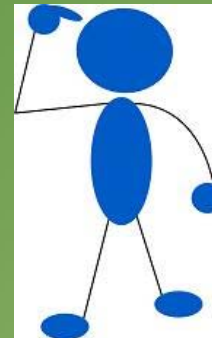


❖ Typically a name, word, phrase, logo, symbol, design, image, or a combination of these elements

# Trademarks

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- ❖ **Why register a trademark if it can be automatically established by use?**
  - ❖ **Constructive notice of the registrant's claim of ownership**
  - ❖ **Legal presumption of the registrant's ownership**
  - ❖ **Sue for trademark infringement in federal court**
  - ❖ **What about suing based on non-registered trademarks?**



# Trademarks

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- ❖ **Why register a trademark if it can be automatically established by use?**
  - ❖ **Basis to obtain registration in foreign countries**
  - ❖ **Prevent importation of infringing foreign**
  - ❖ **Registrant's exclusive right to use the mark nationwide**
  - ❖ **Registrant's exclusive right to use with the goods and/or services listed in the registration**
  - ❖ **Cannot register a picture of your mother-in-law to prevent entry into the country**



# Trademarks

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❖ May be referred to as a service mark (SM)



❖ Unlike Costco samples, trademarks may last forever..

# Copyright

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- ❖ Exclusive right granted to author of an original work
- ❖ Right to ban or authorize publications
- ❖ Examples:



- ❖ What about software??



# Copyright

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❖ *Feist Publications, Inc., v. Rural Telephone Service Co.*, 499 U.S. 340 (1991)



❖ Copyright applies to the creative aspects of information: the creative choice of what data to include or exclude, the order and style in which the information is presented, etc., but not on the information itself.

# Copyright

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❖ **How do comedians show clips of other shows and comment on them?**

❖ **Fair Use Doctrine**

❖ **Purpose and character of use (*e.g.*, Commercial, Non-profit? Transformative *vs.* Derivative?)**

❖ **Nature of the copyrighted work**

❖ **Kennedy Assassination Video / Public Interest**

❖ **Amount and substantiality of the portion used**

❖ **Effect of use upon potential market for or value of the copyrighted work**

❖ **Work for Hire Doctrine**

# Copyright

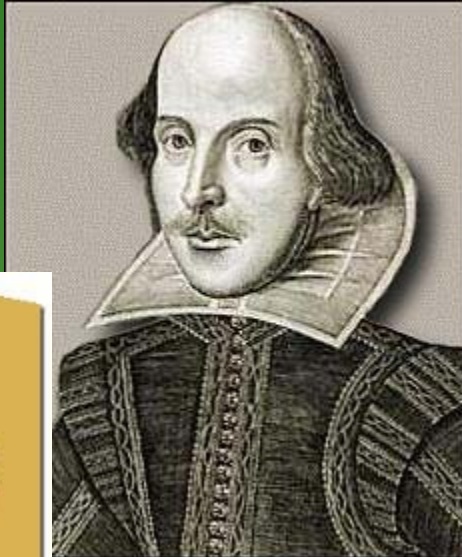
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❖ Copyright applies to any expressible (and creative) form of an idea or information that is substantive and discrete and fixed in a medium.



# Copyright

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- ❖ **Individual: Death + 70 years**
- ❖ **Corporate: 95 years after publication, 120 from creation**

# Copyright

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❖ What is the use of Copyright registration when it is possible to sue without registration?

*Prima Facie* evidence of valid copyright

❖ Statutory Damages (Compensation for work)

❖ Without Registration: Actual Damages & Lost Profits



❖ Can two people have Copyrights on essentially identical works?



# Copyright

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- ❖ **Is a recipe copyrightable?**
- ❖ **Are a collection of recipes copyrightable?**
- ❖ **Are house architectural plans copyrightable?**
- ❖ **Are software design plans copyrightable?**
- ❖ **Is software code copyrightable?**
- ❖ **Are requirements documents copyrightable?**



# Patents

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- ❖ What rights do patents convey?
- ❖ What is the use of patents?
- ❖ What can be patented?
- ❖ What should be patented?
- ❖ What are the legal requirements to obtain a patent?
- ❖ When should patents be pursued?
- ❖ What are the types of patents / patent applications?
- ❖ What is the process for obtaining a patent?
- ❖ What does it cost to obtain a patent?



# Patent Rights

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- ❖ **Right to exclude others from making, using, selling, offering for sale, or importing into the U.S. the claimed invention**
- ❖ **Presumption of validity**
- ❖ **Can be asserted against others in Federal court or before the International Trade Commission (ITC)**
- ❖ **Becomes prior art against others, as of filing date**
- ❖ **Life of 20 years from the filing date**
- ❖ **First to invent entitled to patent (US)**

# Why Patent?

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- ❖ **Protect proprietary technology**
- ❖ **Create tangible evidence of intangible assets**
- ❖ **Build credibility and prestige among peers and competitors**



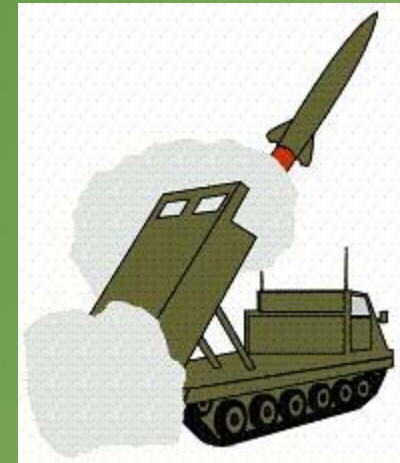
# Why Patent?

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## ❖ Offensive uses

Licensing for revenue

Equitable relief and money damages



## ❖ Defensive uses

Retaliatory threat (avoid royalties and litigation)

Preserve freedom to sell and improve products

Cross licensing

# What Can Be Patented?

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- ❖ **Any process, machine, article of manufacture or composition of matter: “everything under the sun made by man”**
- ❖ **Architectures, protocols, interfaces**
- ❖ **Product features**
- ❖ **Algorithms**
- ❖ **Computer software (Front End & Back End)**
- ❖ **Products and solutions as a whole**
- ❖ **Standards—subject to obligations to standards body**
- ❖ **No prototype, model or implementation is needed**

# What Should Be Patented?

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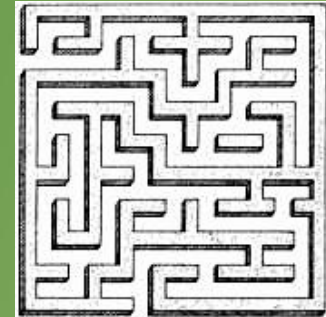
- ❖ **Products and services**
- ❖ **Things that competitors *want* or would find useful, or that provide competitive advantages**
- ❖ **Things which, if copied, *would be detectable* in an infringing system**
- ❖ **At the outset, don't worry about obviousness**



# Is Patenting Hard?

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- ❖ Not as hard as most think
- ❖ About 2,000 patents issue in the U.S. *per week*

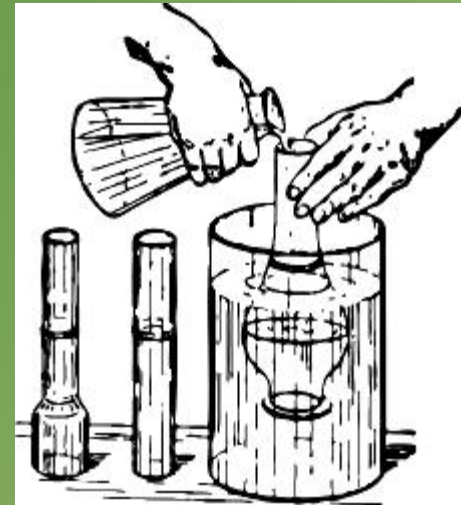


- ❖ Most cover small incremental improvements to existing things

# Legal Requirements

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- ❖ Claimed invention must be new in view of everything that has come before (new combination)
- ❖ Claimed invention must be useful
- ❖ Claimed invention must be non-obvious, to someone of ordinary skill in the field, based on all prior knowledge in the field (“prior art”)



# Non-obviousness

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- ❖ **One or more prior art documents, products or solutions must teach or suggest *all features* of the invention**
- ❖ **When multiple prior art documents are relied upon, the principle operation of the prior art cannot be modified to obtain your invention**
- ❖ **Knowledge of a skilled person in the field would naturally lead to your invention**

# When Should Patents Be Pursued?

## ❖ One-year time bar—must file by 1 year from:

- Released product that contains invention
- Publication or public disclosure or use outside the company
- Sale or offer for sale, *even if under NDA*
- Other countries have no 1-year grace period

## ❖ Disclose inventions early

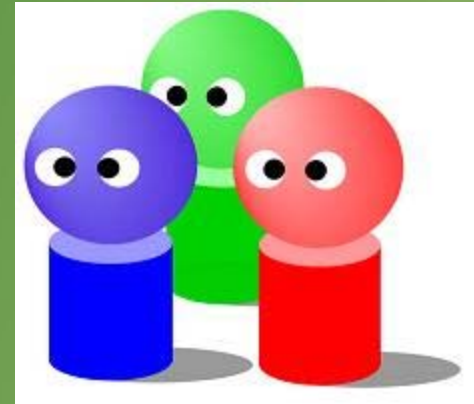
- Release to test
- Upon design freeze or code freeze



# Types of Patents

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- ❖ **Design Patents (14 Years)**
- ❖ **Utility Patents (20 Years)**
  - **Provisional Patent Applications**
  - **Non-Provisional Patent Applications**
- ❖ **Patent Cooperation Treaty (PCT) Applications**
- ❖ **National Phase Applications**



# Timeline / Costs

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- ❖ **Initial Filing Costs**

  - ❖ Attorney Fees

  - ❖ Patent Office Fees

- ❖ **18 Months - Publication**

- ❖ **Additional Prosecution Costs**

  - ❖ Office Action Responses

  - ❖ Request for Continued Examination | Appeal Fees

- ❖ **Annuity Payments**

- ❖ **International Costs (foreign associate fees, fees charged by foreign patent offices)**





# Patent Process—Pre-Filing

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- ❖ **Identify idea**
- ❖ **Prepare brief description for review**
- ❖ **Patent Review Committee (PRC) review and approval**
- ❖ **Disclosure meeting: 1-2 hours**
- ❖ **Patent attorney writes patent application (20-50 pages including implementation examples, drawings, claims)**
- ❖ **Inventor reviews draft: 1-3 hours**
- ❖ **Application is revised and filed**



# Patent Process—Post-Filing

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- ❖ Examiner reviews application, searches prior art, issues report (Office Action)
- ❖ Patent attorney responds & negotiates allowance of claims, in writing and/or by telephone



# Patent Process—Post-Allowance

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- ❖ Patent attorney reviews allowed claims
- ❖ Patent attorney may consult with inventors regarding scope of allowed claims in view of products and services of competitors
- ❖ File divisional, continuation and continuation-in-part (CIP) applications



# Patent Process – Inventor Role

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- ❖ **Identify and define inventions**
- ❖ **Prepare invention disclosure materials for Patent Review Committee**
- ❖ **Attend invention disclosure meeting with patent attorney**
- ❖ **Review drafts of patent application and assist patent attorney to complete filing**
- ❖ **Assist in identifying competitors' products and services at disclosure meeting and after allowance**

# Increasing the Value of Patents

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## ❖ Effective claim coverage

**Forms (method, computer-readable medium, apparatus, device, means-plus-function)**

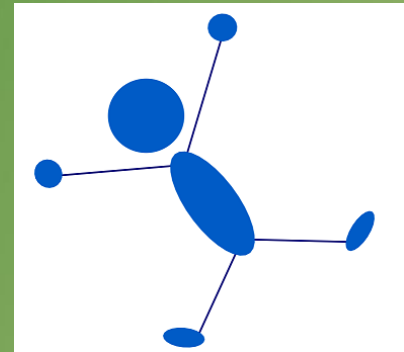
**Adequate scope**

**Single infringer**

**Infringement detectable**

**Draft claims for literal infringement**

**Strong dependent claims**



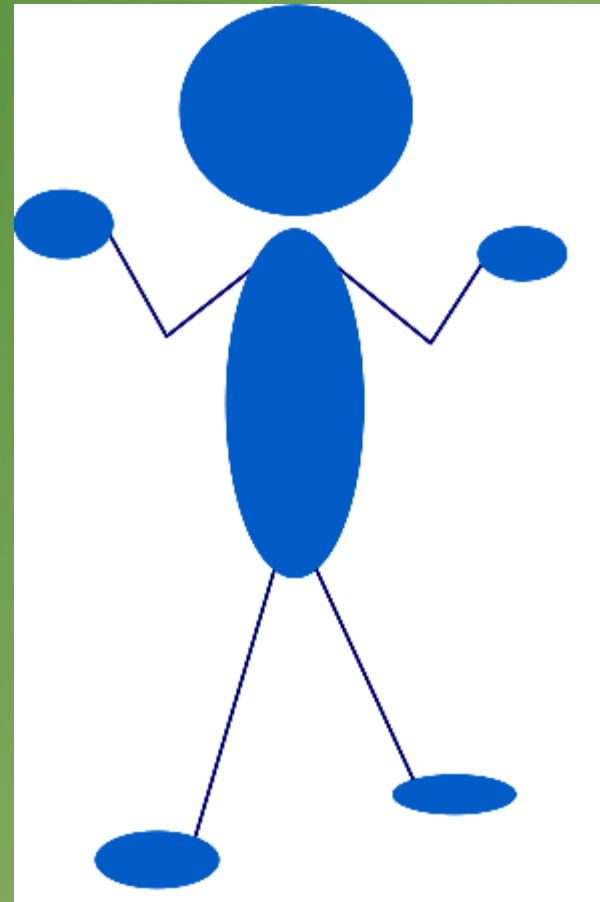
## ❖ Anticipate and limit prosecution estoppel

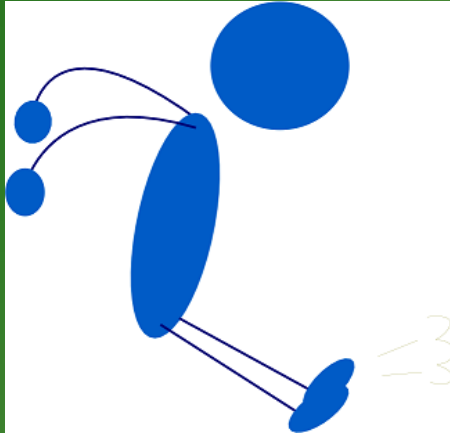
## ❖ Increase numbers

# Patents, Copyrights, Trademarks

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- ❖ Fair Use?
- ❖ Lasts Forever?
- ❖ Identical Allowed?
- ❖ Right to exclude others?
- ❖ Other Questions?





Thank you

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